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First Named Inventor

Mascavage, John Joseph

Art Unit

3628

Examiner Name

Siegfried E. Chencinski

Attorney Docket Number

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ENCLOSURES (Check all that apply)

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Fee Transmittal Form

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Fee Attached

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Amendment/Reply

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After Final

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Affidavits/declaration(s)

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Extension of Time Request

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Express Abandonment Request

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Information Disclosure Statement

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Drawing(s)

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Petition

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Petition to Convert to a
Provisional Application

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Power of Attorney, Revocation
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After Allowance Communication to TC

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Appeal Communication to Board
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Appeal Communication to TC
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Application

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Reply to Missing Parts
under 37 CFR 1.52 or 1.53

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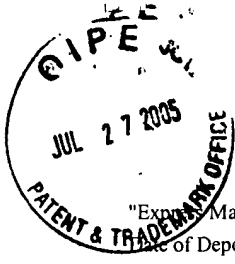
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MAIL STOP: APPEAL BRIEF - PATENTS

Commissioner for Patents

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P.O. Box 1450

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TOWNSEND and TOWNSEND and CREW LLP

By: 

Aurora Lowell

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

John Joseph Mascavage III, et al.

Application No.: 09/991,379

Filed: November 15, 2001

For: ONLINE PURCHASING METHOD

Customer No.: 20350

Confirmation No. 2669

Examiner: Siegfried E. Chencinski

Technology Center/Art Unit: 3628

**APPELLANT'S REPLY BRIEF
UNDER 37 C.F.R. 1.193(b)(1)**

MAIL STOP: Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This brief is filed in triplicate pursuant to 37 C.F.R. §1.193(b)(1), in response to the Examiner's Answer mailed May 31, 2005. A request for an oral hearing pursuant to 37 C.F.R. §1.194 will not be submitted.

I. Status

In the Examiner's Answer, the Examiner maintains the position that all pending claims remain rejected. The Grounds of Rejection, however, has changed due to the Examiner conceding the Appellants' Argument A.

Appellants' Argument A: Whether the Parent Application (09/516,209) supports a limitation in claims 1, 10, and 17

Status: Argument Accepted by the Examiner.

In their appeal, the Appellants argued that their parent application supports a claim limitation in claims 1, 10, and 17. The Examiner Accepted the Appellants' argument "on the basis of being appellant admitted prior art and Appellant's thoroughly documented support for the well known nature of this limitation." (Examiner's Answer, p. 7) By accepting this argument, the Examiner removed the Fung reference (U.S. Patent Publication No. 2002/0055909) as prior art. In its place, the Examiner substituted Appellants' Admitted Prior Art (APA), which the Appellants address below.

Appellants' Argument B: Whether claims 1-7, 9-15 and 17-20 are made obvious by a combination of Wilf & Fung

Status: Rendered moot by Examiner's acceptance of Appellants' Argument A as to Missing Limitations.

In accepting the Appellants' Argument A, the Examiner rendered both aspects of the Appellants' argument B moot. The first aspect of the Appellants' argument related to missing limitations based on Fung. The second aspect related to the alleged motivation recited in Fung. The Examiner issued a New Grounds of Rejection in which Appellants' APA is used as a reference for the claim limitations allegedly taught by Fung. The Examiner cited a new motivation to combine references, the previous motivation being found in Fung. The new motivation is found in the Wilf reference (U.S. Patent No. 5,899,980) at Col. 1, ll. 24-27.

The Appellants' response to the new grounds of rejection is presented below in Section III., Appellants' Arguments based on the New Grounds of Rejection.

Appellants' Argument C: Whether claims 8 and 16 are made obvious by a combination of Wilf, Fung & Kolling

Status: Rendered Moot with respect to the Wilf/Fung Combination; Rejection Maintained with respect to the Wilf/Kolling combination.

The Examiner's acceptance of Appellants' Argument A partially renders this argument moot. The now moot portion relates to the combination of Wilf with Fung.

The Examiner's Answer, however, maintains the rejection of claims 8 and 16, basing this rejection in part on the New Grounds of Rejection that combines Wilf with Appellants' APA to reject claims 1, 10, and 17.

Further, in the Examiner's answer, the Examiner provides for the first time a citation to the alleged motivation to combine Wilf and Appellants' APA with Kolling.

II. Rebuttal to Examiner's Response to Arguments

Appellants' Argument A: Whether the Parent Application (09/516209) supports a limitation in claims 1, 10, and 17

The Examiner accepted the Appellants' argument A. In doing so, however, the Examiner mischaracterized the Appellants' argument and distilled from it an overly broad interpretation of Applicants APA. The Appellants argued that it was well known at the time the patent application was filed that "pop-up window," as used in the parent application, was well known to mean "automatically opening a new web browser window" as recited in claim 1 or "automatically opening a window that is viewable by the customer" as recited in claims 10 and 17. The Appellants did not argue, as the Examiner implies, that USE of a pop-up window, as the

Appellants teach in the parent application, was well known. Hence, Appellants' APA is no broader than "pop-up window is synonymous with a new web browser window, automatically opened and viewable by the customer." Any broader interpretation is simply not justified by the Appellants' brief.

Appellants' Argument B: Whether claims 1-7, 9-15 and 17-20 are made obvious by a combination of Wilf & Fung

No rebuttal is necessary, since the Examiner's acceptance of the Appellants' Argument A rendered this argument moot. The Examiner, however, issued a New Grounds of Rejection, which the Appellants address below in Section III., Appellants' Arguments based on the New Grounds of Rejection.

Appellants' Argument C: Whether claims 8 and 16 are made obvious by a combination of Wilf, Fung & Kolling

The Appellants maintain that claims 8 and 16 are not obvious in light of Wilf, Fung (now Appellants' APA), and Kolling because there is no motivation to combine the references. First, in maintaining the rejection of claims 8 and 16 based on the combination of Wilf and Appellants' APA with Kolling (U.S. Patent No. 5,920,847), the Examiner states that one would be motivated to combine the references "to protect a vendor from undue delay in verifying such a transaction while minimizing costs, maintaining certain controls and discretionary actions on behalf of the biller, and simplifying the process for all the parties," in support of which the Examiner cites col. 10, ll. 25-62 of Kolling. That citation, however, does not support the alleged motivation. Moreover, the cited passage fails to motivate one to combine Wilf, Appellants' APA, and Kolling. Hence, there remains no documentary evidence of a motivation to combine Wilf and Appellants' APA with Kolling to achieve the Appellants' claimed invention.

The cited passage from Kolling does not support the alleged motivation since the cited passage relates to the expense of creating an enrollment system and the time-consuming process of processing customers through the enrollment process. None of this has to do with “protect[ing] a vendor from undue delay in verifying such a transaction” as the Examiner alleges the motivation to be. Hence, the motivation fails for at least this reason.

Further, Kolling is used to supply claim limitations relating to “determining that a notification message was not received by the vendor site [the merchant system] within a predetermined time period,” which limitations are missing from the combination of Wilf and Appellants’ APA. The cited passage from Kolling, however, has to do with enrollment systems and the expensive and time consuming process of enrolling customers. Nothing in the passage would motivate one to add the missing limitations allegedly found in Kolling to the Wilf/Appellants’ APA combination. Hence, the alleged motivation fails for this additional reason.

For at least the foregoing reasons, the rejections of claims 8 and 16 should be reversed.

III. Appellants’ Arguments based on the New Grounds of Rejection

Argument D: Whether claims 1-20 are made obvious by a combination of Wilf & Appellants’ APA

The Examiner’s Answer raised a new grounds of rejection namely, that claims 1-7, 9-15 and 17-20 are rejected under 35 U.S.C. §103(a) based on the combination of Wilf with Appellants’ APA. This rejection, however, is deficient since the cited references do not teach or suggest all the claim limitations and because the alleged motivation to combine these references is deficient.

The cited references, Wilf and Appellants’ APA, do not teach or suggest all the claim limitations. Specifically, with respect to claim 1, the cited references do not teach or

suggest “automatically opening a new web browser window for the customer; presenting a transaction amount in the new web browser window, whereby the customer can assent to the transaction amount through interaction with the new web browser window.” As recited above, Appellants’ APA is specifically limited to the notion that “pop-up window” is synonymous with “automatically opening a new web browser window.” That teaching simply fails to supply the missing claim limitations recited above. Hence, claim 1 is believed to be allowable at least for this reason. Claims 10 and 17 include similar limitations and are believed to be allowable for similar reasons.

Moreover, the Examiner’s answer asserts that one of skill in the art would be motivated to combine Wilf with Appellants’ APA “to establish an automated purchasing method which includes efficient automated web based steps and conveniences for validating the payment for an online transaction without exposing the customer’s personal information by maintaining security due to the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).” In addition to being inherently contradictory, the alleged motivation would not cause one of skill in the art to so combine the references in the specific manner suggested by the Examiner.

First, if users are reluctant to transmit credit card account information over the Internet, why would one skilled in the art be motivated to provide an automated purchasing method that includes efficient automated web based steps and conveniences? It seems that, in light of such reluctance, one skilled in the art would be motivated to provide a method that is **non-web based**, the exact opposite of what is alleged. Hence, the motivation fails for at least this reason.

Second, Appellants’ APA is used to supply the missing claim limitations relating to opening a new web browser window. Again, if users are reluctant to transmit credit card account information over the Internet, how would one be motivated to use a new web browser window to receive the information. Web browser windows are used to interact with the Internet. Hence, the alleged motivation fails for this additional reason.

The Appellants' arguments are buttressed by the lack of ANY teaching or suggestion in Wilf that would motivate one to add a pop-up window to the other teachings of Wilf. Wilf's solution addressed the problem of the "great reluctance of the users to transmit credit card account information over the Internet." (Wilf, Col. 1, ll. 24-27, i.e., the alleged motivation to combine Wilf with Appellants APA) According to Wilf's solution, "the customer does not need to transmit sensitive information such as credit card number over the Internet for purchasing goods or services." Hence, any motivation in Wilf to solve the problem by adding a pop-up window would be contrary to both the problem and Wilf's solution.

For at least the foregoing reasons, the New Grounds of Rejection is deficient and claims 1-20 are believed to be allowable. The rejections, therefore, should be reversed.

IV. New Grouping of Claims

The Appellants do not believe grouping of claims is necessary in light of the recently-implemented Appeal Practice. If this is not the case, in light of the Examiner's newly-cited motivation to combine Wilf, Appellants' APA, and Kolling, the Appellants elect to group the claims as follows:

Group 1: Claims 1-7, 9-15, and 17-20, to which Appellants' Argument D applies.

Group 2: Claims 8 and 16, to which Appellants' arguments C and D apply.

V. Conclusion

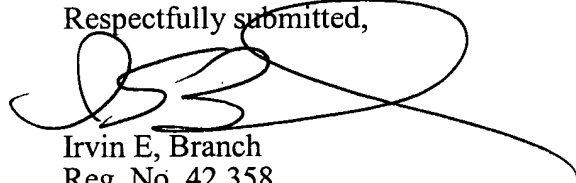
In view of the foregoing, the Appellants believe all claims now pending in this Application are in condition for allowance.

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Attorney Docket No.: 020375-002710US

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
TDF:cmb

60512437 v1

Listing of Claims:

1. (Original) A method for authorizing an online purchase between a customer and a vendor site, the method comprising steps of:
receiving transaction information from the vendor site;
automatically opening a new web browser window for the customer;
presenting a transaction amount in the new web browser window, whereby the customer can assent to the transaction amount through interaction with the new web browser window;
receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and
notifying the vendor site of authorization.
2. (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, wherein the new web browser window points away from the vendor site.
3. (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, further comprising a step of receiving account information from the customer corresponding to an account authorized for the debit.
4. (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, wherein the new web browser window overlays an existing web browser window of the vendor site.
5. (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, wherein the receiving transaction information step triggers the automatically opening step.

6. (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, further comprising a step of transferring payment to an account associated with the vendor site after authorization is received.

7. (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, further comprising a step of presenting a message to the customer in the new web browser window indicating at least one of the following:

- that authorization was canceled by the customer;
- that authorization was rejected by a funds transfer system; and
- that authorization completed normally.

8. (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period.

9. (Original) A computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing the online purchase between the customer and the vendor site of claim 1.

10. (Original) A method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

- receiving transaction information from the merchant system;
- automatically opening a window that is viewable by the customer, wherein the window is formulated by a funds transfer system at a network location away from the merchant system;
- presenting a transaction amount in the window, whereby the customer can assent to the transaction amount by interacting with the window;

receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and
notifying the merchant system of authorization.

11. (Original) The method for checking-out from the online purchase by the customer from the merchant as recited in claim 10, further comprising a step of receiving account information from the customer corresponding to an account available for debits by the funds transfer system.

12. (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, wherein the window overlays an existing web browser window of a web site associated with the merchant system.

13. (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, wherein the receiving transaction information step triggers the automatically opening step.

14. (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, further comprising a step of transferring payment to an account associated with the merchant system after authorization is received.

15. (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, further comprising a step of presenting a message to the customer in another window indicating at least one of the following:
that authorization was canceled by the customer;
that authorization was rejected by the funds transfer system; and
that authorization completed normally.

16. (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, wherein the notifying step

comprises a step of determining that a notification message was not received by the merchant system within a predetermined time period.

17. (Original) A method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

- receiving account information from the customer corresponding to an account available for debits by the funds transfer system;
- automatically opening a window that is viewable by the customer, wherein the window is formulated by the funds transfer system at a site away from the merchant system;
- presenting a transaction amount in the window, whereby the customer can assent to the transaction amount by interacting with the window;
- receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and
- notifying the merchant system of authorization.

18. (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 17, wherein the account information is received through the window.

19. (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 17, further comprising a step of receiving transaction information from the merchant system.

20. (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 17, further comprising a step of transferring payment to an account associated with the merchant system after authorization is received.